

REMARKS

Claims 22-60 are pending in the Application. Claims 22-32, 34-47, 49-58, and 60 stand rejected, and claims 33, 48, and 59 are objected to in the Office action mailed November 25, 2009. Claims 22, 36, and 50 are amended and claims 33, 46-48, 58, and 59 are cancelled by this response. Claims 22, 36, and 50 are independent claims from which claims 23-35, 37-49, and 51-60 depend, respectively. Applicants respectfully request reconsideration of pending claims 22-32, 34-45, 49-57, and 60, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

Objections to Claims

Claim 36 was objected to due to informalities. The Office, at page 2, requests the Applicants to replace the phrase “capable of” with the phrase “operable to” where applicable. Applicants have previously respectfully disagreed with the assertion by the Office that the use of the phrase “capable of” is somehow improper, and does not positively recite the claim limitations, or “make the claim to not perform the intended functionality or produce the desired result,” as previously asserted. See Office action of April 14, 2009 at pages 2-3. Notwithstanding the above, Applicants have amended claim 36 as shown above to avoid the use of the phrase “capable of,” solely at the requirement of the Office. Applicants respectfully submit that these amendments to claim 36 do not add new matter, nor give rise to any estoppel. Applicants respectfully submit that the objection to claim 36 is thereby overcome.

Claims 33, 48, and 59 were object to as being dependent on a rejected base claim, but were deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended independent claims 22, 36, and 50 to include the features of claims 33, claims 46-48, and claims 58 and 59, respectively, and respectfully submit that by these amendments claims 22, 36, and 50, and any claims that depend therefrom, are made allowable. Applicants have cancelled claims 33, 46-48, 58, and 59.

Rejection of Claims

Claims 22, 36, and 50 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984. Claims 23, 24, 29-32, 34-37, 42-46,

49, 50, 54-57, and 60 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, *et al.* (US 5,526,353, hereinafter "Henley") and Chan, *et al.* (US 5,559,861, hereinafter "Chan"). Claims 25, 26, 38, 39, 51, and 52 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, and Heath, *et al.* (US 5,231,646, hereinafter "Heath"). Claims 27, 28, 40, 41, and 53 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Heath, Chan, and Avery, *et al.* (US 5,287,384, hereinafter "Avery"). Claims 47 and 58 were rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,850,510 and claims 1-21 of U.S. Patent No. 5,726,984 in view of Henley, Chan, and Sharman, *et al.* (US 5,774,854, hereinafter "Sharman"). Applicants respectfully traverse the rejections.

I. Non-Statutory Obviousness Type Double Patenting

Applicants respectfully submit that the rejections of all of claims 22-60 on the grounds of nonstatutory obviousness-type double patenting are based on claims 1-25 of U.S. Patent No. 6,850,510 in view of claims 1-21 of U.S. Patent No. 5,726,984. Applicants do not agree with the Examiner's rejection. Nevertheless, in an effort to move the Application to allowance, Applicants are submitting a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c), disclaiming the terminal part of this application that extends beyond October 5, 2015 plus any applicable patent term extension, to obviate

the double patenting rejection. Applicants respectfully submit that the obviousness-type double patenting rejection is overcome.

Conclusion

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-32, 34-45, 49-57, and 60 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: February 26, 2010
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